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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Ser. No. 76/245,902 - OG 12/11/01

SAVATAR, INC.,

Opposer,

-v-

SAVITAR CORPORATION,

Applicant.

Opposition No. 124,976



06-26-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

TRADEMARK TRIAL AND
APPEAL BOARD
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SAVITAR'S MOTION TO COMPEL DOCUMENTS FROM OPPOSER

Comes now the Applicant, Savitar Corporation ("Savitar"), and moves this Board to compel Opposer to provide Savitar with the information requested in discovery. In connection with its motion, Savitar states the following:

1. On April 26, 2001, Savitar properly filed its Intent To Use Application with the United States Patent and Trademark Office. Thereafter (in November 2001), Opposer filed an application for trademark. Opposer then filed an opposition to Savitar's application, claiming that it has used its mark since September 1997 and that its alleged use of its mark is a basis for opposition.

2. On March 8, 2002, in connection with the opposition proceedings, Savitar served a set of simple Requests for Production and Interrogatories to Opposer. On April 12, 2002, Opposer served its discovery responses and answers. Opposer's discovery responses and answers were incomplete and filled with improper objections.

3. On April 18, 2002, the undersigned counsel sent a letter to Opposer's counsel asking that she reconsider the most egregious of the improper answers and objections to Savitar's discovery. The letter specifically listed some of the improper objections and/or incomplete answers and asked that they be discussed. See letter dated April 18, 2002, a copy of which is attached hereto as Exhibit A.

4. Opposer failed, whatsoever, to respond to this letter.

5. On May 15, 2002, the undersigned counsel sent a facsimile to Opposer's counsel, asking her to again reconsider her improper objections and incomplete answers to Savitar's discovery. The undersigned counsel requested a response to the letter "so that we can avoid a motion to compel." See facsimile letter dated May 15, 2002, a copy of which is attached hereto as Exhibit B.

6. Opposer finally responded with a single statement that it had no intention of providing any further information to Savitar. See facsimile letter dated May 16, 2002, a copy of which is attached hereto as Exhibit C.

7. Because Opposer refuses to produce the requested information, Savitar is forced to file this motion to compel.

8. The following answers and responses by Opposer are improper. A copy of each of the relevant answer or response is attached hereto as exhibit D.

A. Interrogatory Nos. 7 & 8

Interrogatory number 7 asked Opposer to "list the customers (including name and location) using [Opposer's] software development services." Interrogatory number 8 asked for the same information, but in connection with Opposer's "consulting services." Opposer answered both of these interrogatories by providing only a list of some of the "recent" clients

which have been “publicly disclosed.” Furthermore, it completely ignored the portion of the interrogatory which sought the location of each such customer.

Opposer is claiming that it has used its mark only since 1997. Therefore, these interrogatories seek information from less than five years. Opposer should be required to produce a list of its clients for the last five years so that Savitar can explore the allegations that Opposer has continuously used its mark and that its mark has valuable goodwill. Savitar asked that Opposer complete its answer by at least “providing the location of these customers.” The location of such customers has proven vital for Savitar to complete its discovery. Specifically, Savitar sent non-party discovery to the few customers which were identified by Opposer, asking them to produce examples of Opposer’s mark as it was used with each of them. Many of these customers are larger corporations with many locations. The customers have been unable to find any reference that they were clients of Opposer. See e.g., letter dated May 29, 2002, a copy of which is attached hereto as Exhibit E.

Savitar is entitled to the information which it requested. If Opposer continues to refuse to provide such information, it should be prohibited from offering any evidence/claims regarding the alleged use of its mark with any such customers.

B. Interrogatory Nos. 9 & 10

Interrogatory number 9 asked Opposer to “state the number of customers who presently use Savitar’s software product and the date when such software was purchased.” Interrogatory number 10 asked for the same information, but in connection with Opposer’s “consulting services.”

Opposer objected to these interrogatories, claiming that the number of alleged customers is somehow confidential information. This objection is completely without merit. Opposer fails

to explain how the number of its customers and year that the entity became a customer could be “confidential.” Accordingly, Savitar asked Opposer to reconsider its objection – “[e]ven if you claim that the identity of [Opposer’s] customers are confidential, it is impossible for the claimed number of customers (and years that these numbers existed) to be confidential.” Opposer continues in its refusal to provide such information.

Savitar is entitled to determine the number of customers which Opposer alleges it has and the time period in which such customers allegedly existed.

C. Interrogatory No. 14

Interrogatory number 14 asked Opposer to “state any amount of money attributed to ‘good will’ in any financial statement, tax document or accounting of any kind and specifically identify such document.” This interrogatory is especially proper because in its opposition, Opposer alleged that it “developed a valuable goodwill and reputation in its mark.”

Savitar responded by providing only an unsubstantiated/undocumented guess as to how much it allegedly invested in its mark. Opposer objected to providing any other information, claiming that it is irrelevant. However, because Opposer claims that it “developed a valuable goodwill” in its mark, Savitar is entitled to know what “value” has been assigned to it. Accordingly, Savitar asked Opposer to reconsider its objection. Opposer continues in its refusal to provide this requested information.

D. Request No. 1

Request for Production number 1 sought “[c]opies of any and all of Opposer’s advertising which displays Opposer’s use of its mark.” Opposer submitted several objections and produced only two items. First, this request is not too broad in time because Opposer only claims that it has been using its mark for less than five years. Savitar asked Opposer to produce samples of

any other advertising (besides the two items – its website and brochure) which may exist.

Opposer refused to provide such information. Opposer should be compelled to produce samples of this information or should be precluded from claiming/introducing evidence that it somehow had any other advertising which included its mark.


E. Request No. 2

Request for Production number 2 sought “[a] sample product packaging, brochures and stationery displaying Opposer’s mark.” Opposer failed to produce any product packaging. Because Opposer’s response was filled with improper objections, it was impossible to determine if no product packaging exists or whether such packaging exists but Opposer refuses to produce such. Accordingly, Savitar asked Opposer to reconsider its objection by providing Savitar a sample of its product packaging if it existed. The only response received from Opposer was that it refuses to provide any additional information. Opposer should be required to respond appropriately to this request.

9. Opposer has refused to fully answer and respond to Savitar’s interrogatories and requests. Savitar has attempted to resolve these issues in good faith. However, Opposer will not cooperate.

WHEREFORE, Applicant, Savitar Corporation, prays that this Board enter an order requiring Opposer to fully answer the Interrogatories and fully respond to the Requests for Production of Documents served on March 8, 2002, within fifteen (15) days of entering such order and award sanctions, as this Board deems proper, and for all other just and proper relief on the premises.

Respectfully submitted,



Elizabeth B. Searle
STUART & BRANIGIN LLP
300 Main Street, Suite 800
P.O. Box 1010
Lafayette, Indiana 47902-1010
Telephone: 765-423-1561
Fax: 765-742-8175
Attorney for Savitar Corporation

CERTIFICATE OF SERVICE

I certify that on the 15th day of June, 2002, service of a true and complete copy of the above and foregoing pleading or paper was made upon:

Mary M. Luria
DAVIS & GILBERT LLP
1740 Broadway
New York, NY 10019

by depositing the same in the United States mail in an envelope properly addressed and with sufficient first-class postage affixed.


Elizabeth B. Searle

FILE

**STUART &
BRANIGIN** LLP

LAWYERS

Elizabeth B. Searle
Direct (765) 428-7094
E-mail ebs@stuartlaw.com

www.stuartlaw.com

April 18, 2002

Ms. Mary M. Luria
DAVIS & GILBERT LLP
1740 Broadway
New York, NY 10019

Re: Savatar, Inc. v. Savitar Corporation
Ser. No. 76/245,902 - OG 12/11/01
Opposition No. 124,976

Dear Ms. Luria:

I have received and reviewed your client's discovery responses and answers in connection with the above-referenced matter and find them incomplete.

Please reconsider your objections to Interrogatories Nos. 9 and 10. Even if you claim that the identity of Savatar's customers are confidential, it is impossible for the claimed number of customers (and years that these numbers existed) to be confidential.

Please complete Interrogatories Nos. 7 and 9 by providing the location of these customers.

Please also reconsider your objection to Interrogatory No. 14. In your Opposition you claim that Savatar "has developed a valuable goodwill and reputation" in its mark. Therefore, we are entitled to know the value of goodwill assigned to this mark in any financial statement, tax document or accounting.

Please reconsider your objection to Response No. 1. If any advertising (besides your client's website and brochure) exists, we are entitled to view it. The time limit is not too long in this request because your client claims to have used the mark only since September 1997.

Please reconsider your objection to Response No. 2 by providing us a sample of your client's product packaging.

EXHIBIT A

282556.1

Reply to Lafayette Office

300 Main Street • Suite 800 • P.O. Box 1010 • Lafayette, Indiana 47902 • (765) 423-1561 • Fax (765) 742-8175
8888 Keystone Crossing • Suite 1401 • Indianapolis, Indiana 46240 • (317) 574-7245 • Fax (317) 574-7050

Ms. Mary M. Luria

April 18, 2002

Page 2

I look forward to your response in these matters.

Very truly yours,

A handwritten signature in black ink, appearing to be 'Elizabeth B. Searle', with a long horizontal flourish extending to the right.

Elizabeth B. Searle

EBS:sjc

**STUART &
BRANIGIN^{LLP}**
LAWYERS

FILE

Elizabeth B. Searle
Direct (765) 428-7094
E-mail ebs@stuartlaw.com

www.stuartlaw.com

May 15, 2002

VIA FACSIMILE

Ms. Mary M. Luria
DAVIS & GILBERT LLP
1740 Broadway
New York, NY 10019

**Re: Savatar, Inc. v. Savitar Corporation
Ser. No. 76/245,902 - OG 12/11/01
Opposition No. 124,976**

Dear Ms. Luria:

I note from the file that we have not yet received a response to my letter to you dated April 18, 2002, in connection with your client's discovery answers and responses in the above-referenced matter. For your convenience, I am attaching a copy of that letter to this facsimile. I would appreciate your responding to this letter so that we can avoid a motion to compel.

I look forward to discussing this matter with you.

Very truly yours,



Elizabeth B. Searle

EBS:sjc

Enclosure

EXHIBIT B

282556.1

Reply to Lafayette Office

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8888 Keystone Crossing • Suite 1401 • Indianapolis, Indiana 46240 • (317) 574-7245 • Fax (317) 574-7050

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EMAIL ADDRESS
mgurta@dglaw.com

MAIN FACSIMILE
(212) 468-4888

May 16, 2002

Via Facsimile (No. 765-742-8175)

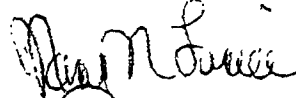
Ms. Elizabeth B. Searle
Stuart & Branigin LLP
The Life Building
300 Main Street, Suite 800
Lafayette, IN 47902

Re: Savitar, Inc. v Savitar Corporation

Dear Ms. Searle:

We are in receipt of your letters of April 18 and May 15 in connection with the above matter. Please be advised that we have no intention of providing you with any further information unless you withdraw each of the subpoenas you have served on Savitar's clients. We are proceeding with discovery on behalf of our client in the PTO proceeding, since current discussions between our clients and communications between their lawyers seem unlikely to result in settlement.

Very truly yours,


Mary M. Luria

cc: David A. Weems, Esq.

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SAVATAR, INC.

Opposer,

v.

SAVITAR CORPORATION,

Applicant.

Opposition No. 124,976

OPPOSER'S RESPONSE TO APPLICANT'S
FIRST SET OF INTERROGATORIES

Opposer hereby responds to Applicant's First Set of Interrogatories by submitting the following responses and objections.

Opposer's responses are made without waiving or intending to waive any objections as to relevancy, privilege, or admissibility of any information provided in response to Applicant's first set of interrogatories in any subsequent proceeding or at the trial of this or any other action, on any ground. A partial answer to any interrogatories that have been objected to, in whole or in part, is not intended to be a waiver of the objection.

EXHIBIT D

- Customize, integrate and implement CRM/PRM applications

Interrogatory No. 7: Please list the customers (including name and location) using Savatar's software development services.

ANSWER:

Opposer objects to this interrogatory on the grounds that it is overly broad, not limited in time, unduly burdensome and seeks the disclosure of information that is neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving these objections or the General Objections, recent client engagements publicly disclosed include, but are not limited to, FedEx, AT&T, Cisco, Domino's Pizza, Verizon, F.X. Coughlin, and Lipton Foodservice. Other customer relationships are confidential.

Interrogatory No. 8: Please list the customers (including name and location) using Savatar's consulting services.

ANSWER:

See Response to No. 7 above.

Interrogatory No. 9: Please state the number of customers who presently use Savatar's software product and the date when such software was purchased.

ANSWER:

Opposer objects to this interrogatory on the grounds that it is overly broad, not limited in time, unduly burdensome and seeks the disclosure of information that is neither

relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving these objections or the General Objections, Opposer responds as follows:

AT&T – 1997, 1998, 2000 (ongoing)

FedEx – 2001

Bravant (J. Walter Thompson-Bravant-1999)

Others are confidential.

Interrogatory No.10: Please state the number of customers who presently use Savatar's computer consulting services and the date when such services were purchased.

ANSWER:

See Response to No. 9 above.

Interrogatory No.11: For each person who you expect to call as a witness in connection with your opposition, state:

- (a) The person's full name and address;
- (b) The subject matter on which the person is expected to testify;
- (c) The substance of the facts and opinions upon which the person is expected to testify; and
- (d) A summary of the grounds for each opinion upon which the person is expected to testify.

ANSWER:

Not known at present.

Interrogatory No.12: With respect to your allegation set forth in paragraph 6 of your Notice of Opposition, please state the "channels of trade" through which Savatar sells its computer software.

ANSWER:

In response to this interrogatory, Savatar primarily works with mid to large size organizations, either at the total enterprise or individual business unit level. Savatar's clients span a broad array of industries, both business-to-business and business to consumer.

Interrogatory No.13: With respect to your allegation set forth in paragraph 6 of your Notice of Opposition, please state the "channels of trade" through which Savatar sells its consulting services.

ANSWER:

See Response to No. 12 above.

Interrogatory No. 14: With respect to your allegation set forth in paragraph 3 of your Notice of Opposition, please state any amount of money attributed to "good will" in any financial statement, tax document or accounting of any kind and specifically identify such document.

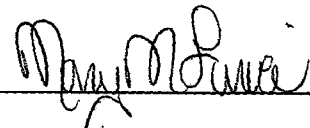
ANSWER:

Opposer objects to this interrogatory on the grounds that it is overly broad, not limited in time, unduly burdensome and seeks the disclosure of information that is neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving these objections or

the General Objections, Savatar, Inc. is a wholly owned subsidiary of the WPP Group, plc, a UK public company. Precise details of financial information concerning the company are confidential. However, an approximate dollar amount spent promoting the name and good will associated with the mark from 1997 to present is estimated to be in excess of \$300,000.

Dated: April 12, 2002
New York, New York

DAVIS & GILBERT LLP

By: 
Mary M. Luria
1740 Broadway
New York, New York 10019
Attorneys for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SAVATAR, INC.

Opposer,

v.

SAVITAR CORPORATION,

Applicant.

Opposition No. 124,976

**OPPOSER'S RESPONSE TO APPLICANT'S
FIRST REQUEST FOR PRODUCTION OF DOCUMENTS**

Opposer hereby responds to Applicant's responds and objects to Opposer's First Request for the Production of Documents and Things ("Applicant's Requests") by submitting the following responses and objections.

Opposer's responses are made without waiving or intending to waive any objections as to relevancy, privilege, or admissibility of any information provided in response to Applicant's Requests in any subsequent proceeding or at the trial of this or any other action, on any ground. A partial answer to any interrogatories that have been objected to, in whole or in part, is not intended to be a waiver of the objection.

GENERAL OBJECTIONS

1. Opposer objects to Applicant's Requests, to the extent that they attempt to impose obligations on Applicant greater than those imposed by the Federal Rules of Civil Procedure.

**SPECIFIC RESPONSES AND OBJECTIONS
TO OPPOSER'S DOCUMENT REQUESTS**

DOCUMENT REQUEST NO. I

Copies of any and all of Opposer's advertising which displays Opposer's use of its mark.

RESPONSE TO REQUEST NO. 1:

Opposer objects to this request on the grounds that it is overly broad, vague, not limited in time, and unduly burdensome. Subject to and without waiving these objections or the General Objections, Opposer produces herewith print-outs from Applicant's website and company brochure (Bates Nos. SAV000003 - SAV000021).

DOCUMENT REQUEST NO. 2

A sample of product packaging, brochures and stationary displaying Opposer's mark.

RESPONSE TO DOCUMENT REQUEST NO.2

Opposer objects to this request on the grounds that it is overly broad, vague, not limited in time, and unduly burdensome. Subject to and without waiving these objections or the General Objections, Opposer produces herewith copies of stationary, a business card, company brochure, and print-outs from Opposer 's website (Bates Nos. SAV000001 - SAV000021).

DOCUMENT REQUEST NO.3

Any catalogs or other evidence of product names and designations that employ Opposer's mark.



Unilever

Stuart M. Cobert
Associate General Counsel - Litigation

May 29, 2002

VIA FACSIMILE

Sandy M. Normington
Paralegal
Stuart & Branigin
300 Main Street
Suite 800
Lafayette, IN 47902

Re: Savitar, Inc. v. Savitar Corporation

Dear Ms. Normington:

Conopco has conducted a reasonable good faith search for documents responsive to your subpoena in the above matter and we have located no responsive documents.

Sincerely,

Stuart M. Cobert

69686.01 5/29/02

Unilever United States, Inc.
Lever House • 390 Park Avenue • New York, New York 10022-4698
Telephone (212) 906-1999 • Facsimile (212) 318-3680
Stuart.Cobert@Unilever.com

EXHIBIT E